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ART UNIT	PAPER NUMBER
3623	16

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/245,798	O'DONNELL ET AL.	
	Examiner	Art Unit	
	Akiba K Robinson-Boyce	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *4/16/02* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

4)☒ Claim(s) *47-83* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *47-83* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachm nt(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Status of Claims

In response to the communication received on 4/16/02, the following is a final office action. Claims 47-83 are pending and have been examined on the merits. Claims 47-83 have been rejected. The following rejection is repeated from the office action of paper #10.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 47-51, 55-59, 64-68, 77-83 are rejected under 35 U.S.C. 102(e) as being anticipated by Kiraly, et al (US Patent 6,088,731).

As per claim 47, Kiraly, et al discloses:

placing on a computer network a server that presents web pages...(Col. 1, lines 39-42, [wherein the Web Site of Kiraly, et al is an accumulation of Web Pages]...

each web page associated with one of a plurality of works of authorship and with a unique work identifier...(Col. 14, line 66-Col. 15, line 5, Col. 15, lines 9-11);

from a server on the computer network, providing to a client computer on the network one of said works of authorship and providing, associated with said work, a hotspot...(Col. 15, lines 21-37, [where the tag of Kiraly, et al is the hot spot of the present invention]).

As per claim 48, Kiraly, et al discloses:

wherein the hot spot includes an icon representing an action to obtain a license relating to the work...(Claim 28).

As per claim 49, Kiraly, et al discloses:

wherein the work of authorship is a text article...(Col. 10, lines 60-62)...

The following is inherent with Kiraly, et al because any text-based document must have a beginning and end to establish the content of the document. In addition, the hot spot, like a link or a tag is customizable and therefore can be placed at any point in order to cater to the user's needs:

having a beginning and an end and the hotspot is located at the end.

As per claim 50, Kiraly, et al discloses:

wherein the unique work identifier is a universal resource...(Col. 10, lines 63-64).

As per claim 51, Kiraly, et al discloses:

wherein the unique work identifier includes an identifier of the publisher...(Col. 15, lines 17-19).

As per claim 55, Kiraly, et al discloses:

wherein each licensing web page includes a hotspot...(Col. 15, lines 14-22, [tag]).

As per claims 56, 64, Kiraly, et al discloses:

wherein the computer network comprises t he global computer network...(Abstract, lines 1-2, [Internet]).

As per claims 57, 77, Kiraly, et al discloses:

placing on a computer network a server that presents web pages...(Col. 1, lines 39-42, [wherein the Web Site of Kiraly, et al is an accumulation of Web Pages];

receiving at the server from one of said client computers...an acceptance.../a receiving component...(Col. 15, lines 10-11, and line 14);

in response to receiving the acceptance, creating on a server on the computer network a record associated with said accepted license.../a licensing record component...(Col. 15, lines 15-25);

providing to said client computer said unique license identifier...(Col. 15, lines 18-19, [here, the licensee is working from a personal/local computer which is classified as a client, see col. 11, lines 7-10]).

a database component...Col. 15, lines 19-25);

As per claim 58, the following is inherent with Kiraly, et al because licensed documents are identified as numbers in order to distinguish them apart and to also determine how early the document was licensed, e.g. the smaller the number, the earlier the license was issued:

wherein the license identifier comprises a number.

As per claim 59, Kiraly, et al discloses:

wherein the record on the server is accessible by a client computer in the form of a web page presenting terms...(Col. 15, lines 6-12 and lines 29-35).

As per claims 65, 81, Kiraly, et al discloses:

generating on the server system a record.../a code generation.../a licensing terms record...(Col. 15, lines 17-21);

providing the identifier from the server system to the client system.../a transmission component...(col. 15, lines 29-35).

The following is inherent with Kiraly, et al's system:

receiving on a server system form a client system publisher account information.../a receiving component...(Col. 15, lines 20-21, [since the intelligent assistant is adding the licensee information, it is inherent that this information was received]).

As per claim 66, Kiraly, et al discloses:

wherein the subsequently published work of authorship comprises content embodied in a web page, the identifier is part of the web page...(Col. 15, lines 17-19, and lines 38-47, Col. 10, lines 63-64).

As per claim 67, the following is inherent with Kiraly, et al:

wherein the uniform resource locator is activated by a click on a hot spot...(Col. 15, line 21-37, Col. 10, lines 60-64]).

As per claim 68, Kiraly, et al discloses:

wherein the client system and the server system communicate via the global computer network...(Col. 15, lines 42-61).

As per claim 78, Kiraly, et al discloses:

wherein each of the plurality of user corresponds to a client system...(Col. 11, lines 7-10).

As per claim 79, Kiraly, et al discloses:

wherein each unique license identifier comprises one of or both of: a visual representation conveying information...web browser...(Col. 15, lines 38-51, and Col. 1, lines 45-550.

As per claim 80, Kiraly, et al discloses:

wherein each record comprises a mark up language...(Col. 11, lines 18-20).

As per claim 82, Kiraly, et al discloses:

wherein the work of authorship comprises content embodied in a web page...(Col. 15, lines 21-37 and Col. 10, lines 60-64).

As per claim 83, Kiraly, et al discloses:

wherein each licensing terms record comprises markup language...(Col. 10, lines 60-64).

Claim 72, 76 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefik, et al (US Patent 5,629,980).

As per claim 72, Stefik, et al discloses:

a registration component that receives registration information...(Col. 27, lines 43-57);

a clearance component...(Col. 28, lines 32-63, Stefik, et al discloses the clearance code through the transmittal of the nonce to repository-2 (See col. 28, lines 57-59 [this indication constitutes a clearance code]).

As per claim 76, Stefik, et al discloses:

wherein the registration and clearance components communicate...over the global...(Col. 1, lines 25-28)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 52, 61, 62, 63, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiraly, et al (US Patent 6,088,731), and further in view of Clearwater (US Patent 5,530,520).

As per claims 52, 63, Kiraly, et al discloses that licensee information is disclosed on the web site/page in Col. 15, lines 20-21, but fails to disclose the following, however Clearwater discloses:

a name of an author...(Col. 5, lines 4-6);

It would have been obvious to one of ordinary skill in the art for the name of an author to be disclosed on a licensing web page because the name of an author is a necessary part which makes up the licensing information. It allows further identification of licensing documents.

As pr claims 61, 62, Kiraly, et al discloses that licensee information is accessed by the intelligent assistant, however fails to specifically disclose the following, however Clearwater discloses:

solicits...a name...an address...(Col. 5, lines 4-6);

It would have been obvious to one of ordinary skill in the art for the name and address of an author to be solicited, recorded and sent as a message because this information is essential for the identification and retrieval of the licensed documents.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kiraly, et al (US Patent 6,088,731), and further in view of Shear, et al (US Patent 6,112,181).

As per claim 53, Kiraly, et al discloses that licensee information is disclosed on the web site/page in Col. 15, lines 20-21, but fails to disclose the following, however Shear, et al discloses:

wherein each licensing web page includes a field in which a type of permission...(Figs 37(A)-37(C), Col. 50, lines 16-23, [right ID field]);
It would have been obvious to one of ordinary skill in the art for each licensing web page to include a field in which a type of permission can be selected in order to regulate the types and amounts of information that a user can access.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kiraly, et al (US Patent 6,088,731), and further in view of Stefik, et al (US Patent 5,629,980).

As per claim 54, Kiraly, et al discloses that licensee information is disclosed on the web site/page in Col. 15, lines 20-21, but fails to disclose the following, however Stefik, et al discloses:

wherein the work of authorship is a text article and the associated licensing web page includes a field in which a portion of the article to be used can be specified... (Col. 39, lines 19-25).

It would have been obvious to one of ordinary skill in the art for the work of authorship to be a text article and the associated licensing web page to include a field in

which a portion of the article to be used can be specified in order to regulate the types and amounts of information that a user can access.

Claims 60, 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiraly, et al (US Patent 6,088,731), and further in view of Shi, et al (US Patent 5,875,296).

As per claim 60, Kiraly, et al fails to teach the following, however Shi, et al discloses:

further comprising the step of the server receiving from a client computer said unique license identifier and using said unique license identifier to find the record...(Abstract, lines 14-22).

It would have been obvious to one of ordinary skill in the art for the server to receive from a client computer a unique license identifier and using the unique license identifier to find the record because this identifier is unique only to a particular record. Using this identifier would ensure the validity of the retrieved record.

As per claim 69, Kiraly, et al discloses:

generating on the server system an identifier...(Col. 15, lines 17-19);

generating on the server system a record...(Col. 15, lines 19-21);

supplying information from a second client system to the server system to specify the desired license...(Col. 15, lines 6-9);

on the server system, receiving from the second client system an acceptance of the terms...(Col. 15, lines 9-11 and line 14).

Kiraly, et al fails to teach the following, however Shi, et al discloses:

sending the identifier from the server system to the first client system...(Abstract, lines 10-12).

including the identifier in subsequently published copies of the works...(Col. 3, lines 37-42);

using the identifier on a second client system to access the record...(Abstract, lines 4-22);

It would have been obvious to one of ordinary skill in the art to include the steps of sending the identifier from the server system to the first client system, the identifier providing information that enables access to the terms for licensing on the server system, including the identifier in subsequently published copies of the works of authorship so that a person viewing one of the works may access the terms for licensing the work on the server system and using the identifier on a second client system to access the record on the server system containing the terms for licensing in order to guarantee that correct, valid license documents are being accessed and processed.

The following is inherent with Kiraly, et al's system because since Kiraly, et al discloses in Col. 15, lines 20-21, that the intelligent assistant is adding the licensee information, it is inherent that this information was received:

receiving on a server system from a first client system publisher account information...

As per claim 70, Kiraly, et al discloses:

wherein the work of authorship comprises content embodied in a web page and the identifier included in the web page...(Col. 15, lines 17-19, lines 38-47 and Col. 10, lines 63-64).

As per claim 71, Kiraly, et al discloses:

wherein the uniform resource locator is activated by a click on a hot spot....(Col. 15, line 21-37, Col. 10, lines 60-64]).

Claims 73, 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik, et al (US Patent 5,629,980) and further in view of Kiraly, et al (US Patent 6,088,731).

As per claims 73, 74, Stefik, et al fails to teach the following, however Kiraly, et al discloses:

wherein the request received by the clearance component from the second client system comprises a request from a web browser...wherein the clearance component further provides along with the clearance code a copy of the work...(Col. 15, lines 38-51, [wherein a copy of the work is analogous to use services of Kiraly, et al]).
It would have been obvious to one of ordinary skill in the art to receive a request by the clearance component from a client system via a web browser and generating the request from a publisher code in order to guarantee the wide area access of and retrieval of valid licensed documents.

Claim 75 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik, et al (US Patent 5,629,980), and further in view of Shi, et al (US Patent 5,875,296).

As per claim 75, Stefik, et al discloses a clearance code through the transmittal of the nonce to repository-2 (See col. 28, lines 57-59 [this indication constitutes a clearance code], but fails to teach the following, however Shi, et al discloses:

wherein each license record is accessible from a client computer as a web page corresponding to the clearance code...(Abstract , lines 14-22).
It would have been obvious to one of ordinary skill in the art for each license record to be accessible from a client computer as a web page corresponding to the clearance code in order to ensure the validity of the displayed licensed document.

Response to Arguments

Applicant's arguments filed 4/16/02 have been fully considered but they are not persuasive.

As per the oath/declaration, the document presented only discloses the residence address, not the post office address. A new oath/declaration identifying the post office address of each inventor is required.

As per claim 47, the applicant argues that the "tag" in Kiraly is not analogous to the "hot spot" of the present invention since the "hot spot" is something that is incorporated into a viewable image transmitted to the user while the "tag" is a small portion of the association with a larger record of information on a server which identifies to a client computer a certain portion of the information on the server of interest. However, since this "tag" identifies a portion of the association with a larger record of information on a server, this information has to be presented in some manner. In Kiraly, this "tag" information is implemented through a Website (See Col. 15, lines 19-30). In a Website environment, information is presented through visual representations.

As per claims 48-56, these claims depend on claim 47 and are therefore rejected for the same reasons as described above with respect to claim 47.

As per claim 57, the applicant argues that Kiraly et al concerns only a single work of authorship rather than a plurality of works of authorship of which one is licensed. However, in Col. 15, lines 7-9, Kiraly et al discloses that licenses are granted to use services or more than one service. In Col. 15, lines 52-66, Kiraly et al shows that a user can obtain a license for a plurality of works of authorship such as a behavior

file to become a sales person, a new animation to resemble Geoffrey the Giraffe, and the latest information about the toys available on the site.

As per claims 58-64, these claims depend on claim 57 and are therefore rejected for the same reasons as described above with respect to claim 57.

As per claim 65, the applicant argues that Kiraly et al doesn't disclose that an identifier might be included in published copies of works of authorship so that a person viewing the work might use the identifier to access on the network terms for licensing the work. However, the identifier is implemented through a Website and can therefore be publicly accessed. (See Col. 15, lines 18-21) . In addition, this identifier is used to retrieve works of authorship on the Website. In Col. 15, line 52-Col. 16, line 4, Kiraly et al discloses that works of authorship are retrieved via identifier which is part of the authorized licensee database.

As per claims 66-68, these claims depend on claim 65 and are therefore rejected for the same reasons as described above with respect to claim 65.

As per claim 77, this claim depends on claim 57 and are therefore rejected for the same reasons as described above with respect to claim 57.

As per claims 78-80, these claims depend on claim 77 and are therefore rejected for the same reasons as described above with respect to claim 77.

As per claim 81, this claim depends on claim 65 and are therefore rejected for the same reasons as described above with respect to claim 65.

As per claim 72, the applicant argues that Stefik et al teaches away from specifying that licensing terms are stored in a record on a server rather than being

attached to a work of authorship. However, Stefik et al discloses that usage rights are attached to the work, but then placed in a repository (see figure 1). Col. 27, lines 43-57 demonstrates that a registration process is needed in order to access the repositories and access the works of authorship. In other words, not just any person can access the work of authorship.

As per claims 73-76, these claims depend on claim 72 and are therefore rejected for the same reasons as described above with respect to claim 72.

As per claim 69, the applicant argues that Kiraly et al does not disclose or suggest that an identifier might be included in a work of authorship so that a person may use the identifier to access the terms for licensing the work. The applicant also discloses that the identifier in Kiraly is the identifier of the licensee, not an identifier of the work of authorship and this identifier is not included in the work of authorship. Also, the applicant argues that the identifier in Shi is not included in a published copy of a work of authorship. As described above with respect to claim 65, the identifier is implemented through a Website and can therefore be publicly accessed. (See Col. 15, lines 18-21) . In addition, this identifier is used to retrieve works of authorship on the Website. In Col. 15, line 52-Col. 16, line 4, Kiraly et al discloses that works of authorship are retrieved via identifier which is part of the authorized licensee database. In addition, the Shi reference does show that the identifier belongs to the licensee, however, the licensee only has access to a certain work of authorship and this identifier is therefore related to that work of authorship. This combination is used to disclose the secure access of a file through usage of an identifier. It is the Kiraly et al reference that

shows the identifier being a license identifier, therefore, the combination of Kiraly et al and Shi discloses the claim limitation.

As per claims 70 and 71, these claims depend on claim 69 and are therefore rejected for the same reasons as described above with respect to claim 69.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30 am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238

[After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A. R. B.
August 16, 2002

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